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09/862,905	05/22/2001	Gary P. Kasner	1915.14US03	9685

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EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 07/14/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,905

Applicant(s)

KASNER ET AL.

Examiner

M. Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 35-48 and 61-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-34 and 49-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Election/Restriction

1. Applicant's traversal of the restriction requirement, presented in paper no. 4, is acknowledged. The traversal is on the ground(s) that the Office Action has not shown that examination of all pending claims would impose an undue burden on the Examiner. This is not found persuasive because the restriction requirement, by itself, establishes that a serious burden would be placed upon the Examiner if more than one invention were to be examined, (e.g., the requirement for restriction sets forth the different classification of each invention as well as the distinction between the inventions). Thus, serious burden would be placed upon examiner to search all claims directed to a plurality, or all, inventions disclosed as well as address all claims to each invention in any and all rejections which may be directed to the plurality of disclosed and claimed inventions.

The requirement is still deemed proper and is therefore made FINAL.

Claims 35-48 remain withdrawn from further consideration along with newly added claims 61-70 with claims 61-70 directed to method of forming a ventilator designated as the invention of Group III in the restriction requirement of paper no. 4.

Claim Rejections - 35 USC § 251

2. Claims 16-34 and 49-60 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46

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USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The language/limitations presented within claims 16-34 and 49-60, (particularly claims 16 and 49), deletes a limitation or limitations which had been presented within claims as by amendments, as well as argued as a basis for patentability over the applied and cited prior art, filed in response to rejections of claims 1, 4, 7, 8, and 9 of the issued patent no. 5,806,269.

Claims 16-34 and 49-60, (particularly claims 16 and 49), cancel limitations to --a plurality of vent panels disposed in a stack "generally proximate to one another, [with] said plurality of vent panels defining said multiplicity of air passages"-- as had been inserted by amendment within claim 1 during prosecution of application serial no. 08/735,598 in order to place the application in condition for allowance. Claims 16-34 and 49-60, (particularly claims 16 and 49), cancel limitations to --a first aperture extending through a first one of the plurality of vent panels "and interrupting at least a portion of the multiplicity of air passages therein"-- as had been inserted by amendment within claim 1 during prosecution of application serial

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no. 08/735,598 in order to place the application in condition for allowance. Claims 16-34 and 49-60, (particularly claims 16 and 49), cancel limitations to --a second aperture extending through a second one of the plurality of vent panels "and interrupting at least a portion of the multiplicity of air passages therein"-- as had been inserted by amendment within claim 1 during prosecution of application serial no. 08/735,598 in order to place the application in condition for allowance.

Claims 16-34 and 49-60, (particularly claims 16 and 49), cancel limitations to --at least a first vent panel and a second vent panel connected to said first vent panel such that said first vent panel is disposed above said second vent panel "to form a stack, said first vent panel and said second vent panel defining said multiplicity of air passages"-- as had been inserted by amendment within claim 4 during prosecution of application serial no. 08/735,598 in order to place the application in condition for allowance. Claims 16-34 and 49-60, (particularly claims 16 and 49), cancel limitations to --at least one first aperture extending through the first vent panel "and interrupting at least a portion of the multiplicity of air passages"-- as had been inserted by amendment within claim 4 during prosecution of application serial no. 08/735,598 in order to place the application in condition for allowance. Claims 16-34 and 49-60, (particularly claims 16 and 49), cancel limitations to --at least one second aperture extending through the first vent panel "and interrupting at least a portion of the multiplicity of air passages"-- as had been inserted by amendment within claim 4 during prosecution of application serial no. 08/735,598 in order to place the application in condition for allowance.

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Claims 16-34 and 49-60, (particularly claims 16 and 49), cancel limitations to --each of said pair of vent parts including a plurality of vent panels “which are interconnected and generally parallel to one another” and disposed in a stack “generally proximate to one another, said plurality of interconnected vent panels defining said multiplicity of air passages”-- as had been inserted by amendment within claim 7 during prosecution of application serial no. 08/735,598 in order to place the application in condition for allowance.

The deleted limitations alluded to above with respect to claims 1, 4, and 7 have also been argued as a basis for patentability of claims 1, 4, and 7 on pages 8, (lines 1-6), 9, (lines 16-20), 11, (lines 1-4), and 12, (lines 1-6), of the October 10, 1990 amendment, during prosecution of application serial no. 08/735,598 in order to place the application in condition for allowance.

Claims 16-34 and 49-60, (particularly claims 16 and 49), cancel limitations to --a pocket defined by and extending at least partially through at least a one of the vent parts with “said pocket being spaced apart from the interior region by the vent part”-- as had been inserted by amendment within claim 8 during prosecution of application serial no. 08/735,598 in order to place the application in condition for allowance. Further, claims 16-34 and 49-60, (particularly claims 16 and 49), cancel limitations to “said pocket being at least partially enclosed along a first side disposed closest to the interior region of the roof ventilator by said one of the vent parts” as well as “said pocket being at least partially enclosed along a second side disposed closest to the exterior region surrounding the roof ventilator by said one of the vent parts” as had been argued as a basis for patentability of claim 8 on pages 2-3 of the July 1, 1991 amendment, during

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prosecution of application serial no. 08/735,598 in order to place the application in condition for allowance.

Claims 16-34 and 49-60, (particularly claims 16 and 49), cancel limitations to --a top panel disposed above a pair of vent parts and formed of a pair of planar plies and an intermediate ply, a recessed area cut in the top panel with the recessed area defining a plurality of openings with "each of said plurality of openings having a pair of side walls defined by the intermediate ply, each of said pair of side walls traversing a generally oval shaped path, such that the top panel may be manually folded across a path disposed within said recessed area"-- as had been inserted by amendment within claim 9, as well as argued on pages 4-5 of the March 4, 1991 amendment, during prosecution of application serial no. 08/735,598 in order to place the application in condition for allowance.

As such, Applicant's introduction of instant claims 16-34 and 49-60 in the present reissue application would constitute an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 16-34, 51, and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16, lines 4 and 10, "each said at least one ventilator section" lacks an antecedent basis within the claim. Line 6, "each said ventilator first panel" lacks an antecedent basis within the claim. Further, it is not clear as to what is being defined by the language of claims 16-34 with lines 4-5 of claim 16 reciting "each said ventilator section configured for parallel abutting contact with the top panel". Do claims 16-34 define an assembled ventilator or merely portions of a ventilator which may be assembled together? The metes and bounds of claims 16-34 can, therefore, not be ascertained.

Claim 51, line 1, "said pluralities of first layer apertures" lacks a proper antecedent within the claim. Otherwise, to what does "said pluralities..." refer? Line 2, "said second layer apertures" lacks an antecedent within the claim.

It has been noted that claim 17 appears dependent upon subsequent claim 21, (which itself appears dependent upon claim 17). As well, claim 33 appears dependent upon subsequent claim 37. It is presumed that Applicant had intended for claim 17 to depend from claim 16 and for claim 33 to depend from claim 17, (claims 18-32 and 34 all being dependent upon claim 17).

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 49-54 and 60 are rejected under 35 U.S.C. 102(a) as being anticipated by Cashman. Cashman discloses, Figs. 1-3, roof comprising a ventilator at the peak thereof with the ventilator having first and second sections symmetrically extending outboard from a longitudinal center line with each section comprising at least one layer with the at least one layer comprising a multiplicity of air passages, (as between each of 26), able to conduct air from inside the roof peak to outside the roof peak and a plurality of apertures 44 extending transversely with respect to the air passages and substantially through the at least one layer with each ventilator section comprising first and second layers 22, 12/18 in stacked relationship. Apertures in the first layer

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can be seen as aligned with corresponding apertures in the second layer. Substantially all of the air passages can be seen as interrupted by the plurality of apertures.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. This application contains claims 35-48 and 61-70 drawn to an invention nonelected with traverse in Paper No. 4 and 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.

A handwritten signature in black ink, appearing to read 'M. Safavi', is positioned above the official stamp.

**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**

M. Safavi
July 10, 2002